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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEYHAN KARAOGUZ and JAMES D. BENNETT

Appeal 2009-008018
Application 10/672,251
Technology Center 2100

Before ST. JOHN COURTENAY III, DEBRA K. STEPHENS, and
JAMES R. HUGHES, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-53. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

STATEMENT OF THE CASE

Invention

Appellants' invention is directed to systems and methods supporting automatic selection of media according to a user profile. (Abstract).

Representative Claim 1

A system supporting the automatic selection of media according to a user profile, the system comprising:

a television display to support the consumption of media;

a user interface accessible via the television display, the user interface displaying at least one media channel comprising media available for consumption;

a storage that stores media, the storage communicatively coupled to the television display, the storage having an associated network address; and

server software that receives a request identifying one or both of the associated network address and/or a user identifier, and responds by *automatically selecting media according to a user-defined profile*, the user-defined profile corresponding to one or both of the associated network address and/or a user identifier, and delivering to the storage, via a communication network, information identifying the selected media, the information for incorporation into the user interface.

(emphasis added regarding disputed limitations).

Rejection

1. Claims 1-53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Nash (PG Publication US 2001/0021994 A1) in view of Cristofalo et al (US 2002/0152117 A1).

GROUPING OF CLAIMS

Based upon Appellants' arguments, we select representative claim 1 to decide this appeal for the group consisting of claims 1-17, 19-26, 28-44, and 46. (*See* App. Br. 8-13). *See* 37 C.F.R. § 41.37(c)(1)(vii).

Based upon Appellants' arguments, we select representative claim 18 to decide this appeal for the group consisting of claims 18, 27, 45, and 53. (*See* App. Br. 13-14).

Based upon Appellants' arguments, we select representative claim 47 to decide this appeal for the group consisting of claims 47-52. (*See* App. Br. 13).

FINDINGS OF FACT

We adopt the Examiner's factual findings as set forth in the Answer. (Ans. 3, *et seq.*).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Under §103, did the Examiner err in finding that the combination of Nash and Cristofalo would have taught or suggested "*automatically selecting media according to a user-defined profile*," as recited in representative claim 1?

2. Under §103, did the Examiner err in finding that the combination of Nash and Cristofalo would have taught or suggested “*wherein the server software supports anonymous media exchange*,” as recited in representative claim 18?
3. Under §103, did the Examiner err in finding that the combination of Nash and Cristofalo would have taught or suggested “*sending by a user a user-defined profile*,” as recited in representative claim 47?

ANALYSIS

Issue 1

Regarding *Issue 1*, Appellants contend that “the user profile is determined and generated by the system, but not defined by the user.” (App. Br. 9, referring to Nash, paras. [0031-0036]). However, we note that Appellants acknowledge that Nash teaches direct user input of preference information: “Nash is clear that any *direct user input of preference information* is merely used for programme selection in *conjunction* with the ratings.” (App. Br. 10, ll. 4-6, emphasis added).

As pointed out by the Examiner (App. Br. 9, 19), Nash teaches that the user may enter “initial information as to his or her interest” (e.g., using a remote control¹) as an “initial profile” that “is continuously updated by

¹ Nash teaches the user may create the initial profile using a menu and selection scheme by entering choices with a remote control device.” (para. [0040]). *Cf. Spec.* para. [37]: “The MES platform 107 also provides the functional capability for a user of the MPS 101 to generate a user profile 111 using, for example, a remote control that interacts with the MPS 101.”

monitoring those programmes watched or recorded.” (para. [0040]). Thus, we agree with the Examiner’s finding that Nash’s user-created “initial profile” would have taught or suggested the claimed user-defined profile, within the meaning of representative claim 1.

We find Appellants’ arguments are premised upon an overly narrow reading of the language of claim 1 which recites in pertinent part: “*automatically selecting media according to a user-defined profile . . .*” (emphasis added).

Since Nash teaches an embodiment where the program selection is performed according to *both* a user-defined profile *and* stored ratings data (paras. [0033-0036]), Appellants appear to be contending that the automatic selection is not performed “*according to [only] a user-defined profile . . .*” (Claim 1; *see also* App. Br. 10). In particular, Appellants contend:

[T]he “system” of Nash is the ultimate determining factor regarding selection. That system, as detailed above, can change and override user preferences. As such, Nash does not describe, teach, or suggest that media is selected “according to,” or “in accordance with” a user-defined profile.
(App. Br. 10).

However, we conclude that the open-ended “comprising:” language recited in the preamble of representative claim 1 does not limit the automatic selection to being performed according to *only* a user-defined profile. Moreover, the word “only” is not recited in the claim so as to limit the selection in this manner. Nor does Nash’s disclosure of an alternative embodiment (that overrides user preferences) negate the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness.

“The transitional term ‘comprising’ . . . is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.” *Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1327 (Fed.Cir. 1999) (citing M.P.E.P. § 2111.03 (6th ed.1997)). “A drafter uses the term ‘comprising’ to mean ‘I claim at least what follows and potentially more.’” *Vehicular Techs. Corp. v. Titan Wheel Int’l, Inc.*, 212 F.3d 1377, 1383 (Fed.Cir. 2000); *see also Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are *essential*, but other elements may be added and still form a construct within the scope of the claim.)(emphasis added).

This reasoning is applicable here. Therefore, we do not agree with Appellants that the Examiner’s claim construction is overly broad, unreasonable, or inconsistent with the Specification. We find unavailing Appellants’ attempt to impute an overly narrow construction via argument. Moreover, it is well settled that merely providing an automatic means to replace a manual activity that accomplishes the same result is an obvious improvement. *See In re Venner*, 262 F.2d 91, 95 (CCPA 1958).

For these reasons, we find Appellants’ arguments unpersuasive of Examiner error. Therefore, we sustain the Examiner’s obviousness rejection of representative claim 1 and claims 2-17, 19-26, 28-44, and 46 which fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Issue 2

Regarding *Issue 2*, we agree with the Examiner's finding that the combination of Nash and Cristofalo would have taught or suggested "*wherein the server software supports anonymous media exchange*," as recited in representative claim 18.

In particular, we agree with the Examiner's responsive argument bridging pages 20-21 of the Answer referring to an embodiment of Cristofalo where regional information is used to target advertising on a per-region basis, as opposed to targeting ads based on user-specific information. (See Cristofalo, paras. [0034-0036], e.g., "a receiving system 104 may be configured to respond to a regional, demographic, or other generic (non-user specific) indicator." (para. [0036]). We also observe that the Appellants' Reply Brief fails to specifically address the Examiner's findings and explanations.

For these reasons, we sustain the Examiner's obviousness rejection of representative claim 18 and claims 27, 45, and 53 which fall therewith.² See 37 C.F.R. § 41.37(c)(1)(vii).

Issue 3

Regarding *Issue 3*, we agree with the Examiner's finding that the combination of Nash and Cristofalo would have taught or suggested "*sending by a user a user-defined profile*," as recited in representative claim 47:

² As argued by Appellants, claims 27 and 53 recite similar language: "the user is unknown to the source." (See App. Br. 13, last paragraph).

Nash teaches two methods of creating a user-defined profile. The user can use a menu selection for defin[ing] the user profile, thereby sending information to the system for which media to retrieve to match the user's interest. Additionally the profile is sent by the user through selection by a remote control by the user of media of interest that creates profiled information for accessing additional media of interest.
(Ans. 20; *see also* Nash para. [0040].

We also conclude that method claim 47 does not specify who or what the user-defined profile is sent to. Therefore, we do not agree with Appellants that the Examiner's claim construction is overly broad, unreasonable, or inconsistent with the Specification.

For these reasons, and for the reasons previously addressed regarding claim 1, we sustain the Examiner's obviousness rejection of representative claim 47 and claims 48-52 which fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

DECISION

We affirm the Examiner's § 103 rejection of claims 1-53.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

ORDER
AFFIRMED

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